

Application No. 10/014,452

REMARKS

Review and reconsideration on the merits are respectfully requested.

Applicants appreciate the Examiner's indication that several rejections have been overcome.

Claims 1, 4, 6-12, 14-16, 18, 21, and 22-25 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al. and further in view of Schlueter, Jr. et al. In response, Applicants traverse the rejection.

Applicants submit herewith a graph showing the various disclosures of the references. It is clear that none of the references teach or suggest an electrically conductive filler in combination with an adhesive. Therefore, because none of the references teach or suggest all the elements of the claims, Applicants respectfully submit that a *prima facia* case of obviousness has not been made.

Claims	Parker, et al.	Arnold, et al.	Schlueter, Jr., et al.
Interlocking Seamed Belt	Yes - interlocking seamed belt	No	Yes - interlocking seamed belt
Polyimide Substrate	Yes - polyimide substrate	No - adhesive is for use for enhancing adhesion to polyester	Yes - polyimide substrate
Polyamide Adhesive	Yes polyamide strip adhesive	Yes polyamide adhesive	No a) polyvinyl butyral composition comprising a terpolymer of polyvinyl butyral, polyvinyl alcohol, and polyvinyl acetate, and a plasticizer; b) a polyurethane composition including a polyester polyurethane polymer; or c) a blended composition including an acrylonitrile butadiene copolymer and a phenyl formaldehyde polymer.
Adhesive a) 0.1-80% oxalic acid	No	Yes - Oxalic acid	No
Adhesive b) electrically conductive filler	No	No	No - not with adhesive, but with polyimide belt
Adhesive c) plasticizer	No	Yes - bisphenol plasticizer	Yes

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Applicants respectfully submit that it is clear from the above graph that the rejection has been made in hindsight, and that the Examiner is picking and choosing various parts of different references in order to come up with the claimed invention. In addition, Applicants again submit that none of the references teach or suggest use of a filler in combination with an adhesive. Therefore, because none of the references teach or suggest all the elements of the claims, Applicants submit that the present claims are not rendered obvious in view of the cited references.

Applicants submit that neither the primary nor secondary reference teaches use of electrically conductive filler in a polyamide adhesive. The Examiner recites Schlueter, Jr., et al. as teaching an electrically conductive filler in an adhesive. Applicants made a clerical error when Applicants stated in the last response that Schlueter, Jr., et al teaches a filler in combination with the adhesive. Instead, Applicants point out that Schlueter, Jr. et al. teaches a filler in combination with the polyimide belt substrate, and not in combination with the adhesive, as suggested by the Examiner. The Examiner points to col. 6, line 50, wherein the reference teaches fillers in combination with the polyimide substrate and not the adhesive. Schlueter, Jr. et al does not teach a filler in combination with an adhesive as claimed. In fact, none of the references do. Therefore, Applicants submit that a *prima facia* case of obviousness has not been made.

Schlueter, Jr., et al. teaches an adhesive comprising a) polyvinyl butyral composition comprising a terpolymer of polyvinyl butyral, polyvinyl alcohol, and polyvinyl acetate, and a plasticizer; b) a polyurethane composition including a polyester polyurethane polymer; or c) a blended composition including an acrylonitrile butadiene copolymer and a phenyl formaldehyde polymer. The reference does not teach or suggest a polyamide adhesive as claimed and as taught by both Parker, et al. and Arnold, et al. Applicants submit that one of ordinary skill would not have been motivated to combine the references cited.

To begin with, Parker, et al. teaches use of a polyamide adhesive in combination with a polyimide belt. On the other hand, Arnold, et al. teaches use of a polyamide adhesive in combination with a polyester material (col. 1, lines 43-46; and Example 2, col. 5, lines 17-20). And finally, Schlueter, Jr. et al. teaches a polyimide belt having a polyurethane adhesive, a polyvinyl adhesive or a blended composition of acrylonitrile and butadiene copolymer and a phenol formaldehyde polymer adhesive. Therefore, Applicants submit that one of ordinary

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skill in the art would not have been motivated to use a polyamide adhesive containing an oxalic acid and bisphenol plasticizer as taught by Arnold, et al. in combination with a polyester, as plasticizers in a polyamide adhesive in combination with a polyimide belt as taught by Parker, et al., and then pull in a filler recited by Schlueter, Jr. et al. as being used in a polyimide belt and not in an adhesive.

Applicants respectfully point out that specific adhesives work well with only specific types of materials. Further, fillers work differently when placed in different materials and different adhesives. Applicants submit that there would not have been any expectation of success that a polyamide adhesive taught in combination with a polyester material, would work well as an adhesive for a polyimide belt as claimed and as taught by Parker, et al. Applicants further submit that there would have been no expectation of success that a filler taught for use with a polyurethane, or polyvinyl composition, or blend of acrylonitrile and butadiene and phenol formaldehyde adhesive, would be successful if used in combination with a polyamide adhesive.

The Examiner states that polyimides and polyesters are both thermoplastics, and therefore, it would have been obvious to use an adhesive taught for use with a polyester ((Arnold, et al.) with a polyimide substrate (Parker, et al.). Applicants submit that the polyesters have completely different chemistry. In addition, the two polymers have completely different electrical and mechanical properties. There would have been no expectation of success that an adhesive that is taught to work well with a polyester, would work well with a polyimide.

In addition, Applicants point out that Schlueter, Jr., et al. teaches a completely different plasticizer than that as claimed and as taught by Arnold, et al. Instead, the reference at col. 10, lines 28-29, teaches a plasticizer of dialkyl phthalate. Therefore, Applicants submit that one of ordinary skill in the art faced with the teachings of a plasticizer comprising dialkyl phthalate, would not have been motivated to alter the plasticizer into the plasticizer of Arnold, et al., absent some teaching or suggestion.

In view of the above, Applicants submit that the claims are not obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 4, 6-12, 14-16, 18, 21, and 22-25 under 35 USC §103 as obvious over Parker, et al. in view of Arnold, et al.

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Claim 13 has been rejected under 35 USC §103 as obvious over Parker, et al., Arnold, et al., and Schlueter, Jr., et al., in view of Yamasaki, et al. In response, Applicants traverse the rejection.

Claim 13 depends from claim 1, and therefore, Applicants repeat the above arguments as to why one of ordinary skill in the art would not have been motivated to combine the references. In addition, Applicants submit that none of the primary, secondary or tertiary references teach or suggest the claimed electrically conductive filler in combination with an adhesive.

Applicants note that the Examiner states that Yamasaki, et al. teaches an electrically conductive filler as a quaternary ammonium salt for the purpose of creating an electrically conductive polyurethane foam. Applicants respectfully submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the electrically conductive filler taught for use with a polyurethane foam on an electrically conductive roller, and use that electrically conductive filler with an adhesive material. Applicants further submit that it is an even greater stretch to argue that one of ordinary skill in the art would have been motivated to use an electrically conductive filler taught for use with a polyurethane foam, as a filler in a polyamide adhesive material. Not only does Yamasaki, et al. not teach an adhesive material, and use of an electrically conductive filler therein, but Yamasaki, et al., also does not teach or suggest a polyamide material in combination with an electrically conductive filler. Therefore, Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the electrically conductive filler as taught by Yamasaki, et al., in combination with a polyurethane foam, as a filler in a polyamide adhesive. Applicants further point out that a polyurethane foam material is completely distinguishable from a polyamide adhesive.

In view of the above, Applicants submit that claim 13 is not rendered obvious in view cited combination. Accordingly, Applicants request withdrawal of the rejection of claim 13 under 35 USC §103 as obvious over Parker, et al., Arnold, et al., and Schlueter, Jr., et al., and further in view of Yamasaki, et al.

Claim 17 has been rejected under 35 USC §103 as obvious over Parker, et al., in view of Arnold, et al., and Schlueter, Jr., et al. and Pistoia. In response, Applicants traverse the rejection.

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Claim 17 ultimately depends from claim 1, and therefore, Applicants repeat the above arguments as to why one of ordinary skill would not have been motivated to combine the first three cited references. In addition, none of the primary, secondary or tertiary references teach or suggest the claimed electrically conductive filler in combination with an adhesive.

In addition, Applicants submit that Pistoia is not in the same field of endeavor as the present claims, and as Parker, et al, Arnold, et al. and Schlueter, Jr., et al. Pistoia relates to a vanadate cathode active material and method of making, and to electric current producing and storage cells. The present claims are directed to an endless seamed flexible belt and not to electric producing or storage cells. Applicants submit that the teachings of the quaternary reference are not remotely related to the teachings of the primary, secondary or tertiary references.

Applicants further submit that Pistoia does not recognize the problem solved by the present invention, which is further evidence of a non-relevant reference that is not in the same field of endeavor. The present specification starting at page 6, line 14, states that the problem to be solved by the invention includes providing an adhesive between seaming members, wherein the height differential between the seam and the belt is virtually nil, and wherein the occurrence of ripples and tenting at the seam is reduced or eliminated. Another problem solved is providing an adhesive that is resistant to alcohol and organic solvents. Pistoia does not recognize any of the problems solved by the present invention. This is evidence that Pistoia is not in the same field of endeavor as the present invention, and is not a relevant reference.

The Examiner states that one of ordinary skill would have been motivated to use the polypyrrole of Pistoia, "in order to create a cell comprising a variety of electrolytes, current collectors and cathode compositions." However, there is no teaching in the primary, secondary or tertiary reference to create a cell, and the present claims are not directed to a cell, but to an endless seamed flexible belt.

Accordingly, Applicants submit that Pistoia is not a relevant reference, and that one of ordinary skill would not have been motivated to combine the teachings of Pistoia with the primary, secondary and tertiary references.

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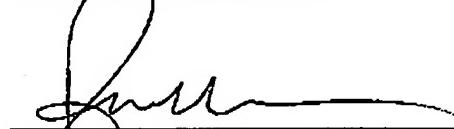
Therefore, Applicants submit that claim 17 is not rendered obvious in view of the combination of Parker, et al., in view of Arnold, et al., and Schlueter, Jr., et al. and Pistoia.

In view of the above arguments and amendments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682.

Respectfully submitted,



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